

## **REMARKS**

Claims 1-16 are pending in the application. Claim 17 has been cancelled without prejudice.

Reconsideration of the application is respectfully requested for the following reasons.

### **Claim Objections**

It is respectfully submitted that the amendments cure the objections of paragraph 5 of the Detailed Action.

### **Rejection of Claims 1-16 under 35 U.S.C. §112, second paragraph**

According to the MPEP 2173.05, “the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” MPEP Section 2173.05, citing *Energizer Holdings Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006)(holding that "anode gel" provided by implication the antecedent basis for "zinc anode"); *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid").

The rejection of claims 1-16 is respectfully traversed on grounds that a person of ordinary skill in the art would be able to reasonably ascertain the scope of the claims. It is respectfully submitted that it is very clear from the claims that the process involves determining whether the financial institution holding one credit account is related to the financial institution holding the other credit account. The examiner has not provided any reasoning for why the claims are unclear other than a simple statement in each case that there was “insufficient antecedent basis for the limitation.” As explained in the MPEP, that reason, by itself, does not make a claim indefinite. Similarly, it is submitted that one of ordinary skill in the art would understand that references to “balance transfer request” and “received balance transfer request” refer to the request for transferring balances recited in the first element of claim 1.

Nevertheless, in order to advance prosecution, Applicants have made amendments to claims 1, 5, 6, 7, 8, 11, 13, 14 and 16 that should satisfy the examiner's formalistic requirements. It is submitted that the amendments do not narrow the scope of the claim. These amendments are being made for no other reason. They are not being made in response to the rejection under §103.

Rejection of Claims 1-16 under 35 U.S.C. §103

In responding to this rejection, Applicants will focus on independent claims 1, 14 and 16 with the understanding that if these independent claims are patentable, all dependent claims are patentable. Therefore, failure to specifically address errors in the reasoning associated with any of the dependent claims or in the interpretation given to the claims or prior art does not constitute a waiver or acquiescence in the examiner's reasoning or reading of the claim or prior art. Applicants respectfully reserve the opportunity to complain of these additional errors.

The rejection of the independent claims is premised on the combination of U.S. Patent No. 5,590,038 of Pitroda ("Pitroda") and U.S. Patent No. 6,267,292 of Walker, et al. ("Walker"). The examiner explains that "Pitroda teaches as disclosed above, but it may be argued that it does [n]ot explicitly teach about balance or debt transfer from one account to another by the same card holder." However, the examiner nevertheless goes on to conclude that it would have been obvious to modify the teachings of Pitroda in view of Walker. Walker, he asserts, explains that it is "well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer which draws the old account balance onto the new credit card account." In the examiner's view, it would have been obvious to modify Pitroda, without explaining exactly how, in order to make a "more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder...."

Applicants traverse the rejection on grounds that the examiner has not, in fact, provided a coherent explanation of the reasons for his conclusion of obviousness and, in any event, the combination of Pitroda and Walker, does not in fact meet all of the limitations in the claims. Thus, he has not met his burden of proving a *prima facie* case of obviousness.

Turning first to the examiner's burden, the Board recently explained in *Ex parte Wada et al.*, Appeal 2007-3733 (BPAI January 14, 2008), the burden has follows:

When determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)). ... It is well settled that the “Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.” *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994). Because the Examiner has not explained why every limitation in claim 1 would have been obvious to a person of ordinary skill in the art, we agree with Appellants that the Examiner has not made out a case of *prima facie* obviousness.

Next, as an initial point of error, applicants submit that the examiner has not made a “searching comparison of the claimed invention ... with the teachings of the prior art” and provided sufficient reasoning for why each claim limitation would have been obvious. The examiner essentially contends, by repeating each of the elements of claim 1, that the entirety of claim 1 is met by the teachings of Pitroda, including the receipt of, eligibility checking for and processing of a “balance transfer request.” He cites the same, very lengthy, multi-page passages as disclosing for most of limitations, but provides not one word of explanation. But then, he states there is no teaching in Pitroda of transferring balances. Applicants are left wondering how these passages are relevant to claim 1. In view of this contradiction, simply citing multiple columns of text without explanation does not inform applicants, and would presumably not inform the Board, of how each of the limitations are met.

Turning to the details, Pitroda seems to describe something completely unrelated to the present invention. It describes a universal electronic transaction card ("UET card"). The specification appears to describe the operation of the UET card itself. The user presents the UET card to a point-of-sale terminal for a sales transaction after choosing the type of credit card to use for the transaction. See Abstract. "The card is capable of storing, transmitting and receiving personal and transactional information and thereby replaces plastic cards which are presently used for the same purpose." Column 2, lines 44-48.

The examiner first contends that nearly a page of text, extending from line 22 of column 13 to line 65 of column 14, and then two pages of text extending from line 12 of column 15 to line 37 of column 17 disclose "receiving at a computer a request for transferring balances from the first credit account to the second credit account." However, after careful review of the cited passages, Applicants can find no mention of receiving at a computer a request for transferring balances between two credit accounts. The passage beginning in column 13 and continuing through column 14, describes FIGS. 9-20. These figures show nothing more than the interface of the card itself during a setup, initialization, data entry selection and transaction processes. There appears to be no mention of transferring a balance between credit accounts, or of a computer receiving such a request. The very fact that the examiner fails to specify where in this very long passage there is a teaching that meets this limitation, suggests that in fact this limitation is not found in the passage nor is it suggested by the passage.

The other cited passage which begins near the top of column 15 and continues through nearly the bottom of column 17, describes an initialization and activation process for using the UET card with a particular credit card service or service institution. It then describes how a user uses a UET card for a transaction, by first turning it on, then entering a security code, then selecting a credit transaction, such as an American Express card. Once the selection has been made, the user provides the card to a sales person who then connects the UET to a communication interface unit ("CIU"). The American Express service then checks credit and sends an authorization number to the CIU as well as optionally update credit card information in the UET card for additional or dynamic security. The transaction is completed in a normal

fashion after that. The remainder of the passage, particularly in column 17, describes the use of the UET card in a health service provider system.

The examiner thus relies on these two extensive passages for supporting a number of limitations, including:

- “receiving at a computer a request for transferring balances from the first credit account to the second credit account;”
- “obtaining account data associated with the first credit account, said account data comprising at least the financial institution with which the first credit account is held;”
- “determining using with a business logic server, using the account data, whether the financial institution with which the first credit card is held is related to the financial institution with which the second credit account is held;” and
- “processing the balance transfer of the request if it meets all of at least one eligibility requirement for transferring the balance, and otherwise not processing the received balance transfer request; the eligibility requirements comprising a requirement that identifying said first credit account as being not eligible for a balance transfer to said second credit account if it is determined that the first credit account is not held with a financial institution that is related to the financial institution with which the second credit account is held.”

There is nothing, in fact, in the cited passages that appear to even remotely suggest these limitations. Thus, not only has the examiner failed to provide sufficient reasoning to support the rejection, the reference does not in fact meet the limitations of the claims in any reasonable way that applicants can discern.

As yet another point of error, the examiner appears to be contending that it would have been obvious to modify the UET card for transferring account balances between credit accounts. However, there is absolutely no indication of how this would be done. Walker teaches only that credit card holders are free to transfer debt between accounts, at least according to the examiner, and that such transfers are usually done by paying off the account with a convenience check or electronic funds transfer. There is no explanation of how the

modification would actually take place and how the UET card would actually function to do this. The generalized allegations of the examiner do not support a conclusion of obviousness.

More importantly, even if the teachings of Pitroda and Walker are combined, such that the UET card somehow magically performs the balance transfer, there is nothing in the combination that applicants can find, and nothing alleged by the examiner, involving any determination made as to whether or not the financial institutions holding the first and second credit card account are unrelated. There is no mention in either Pitroda or Walker of eligibility requirements for transferring credit balances.

Therefore, the examiner has failed to establish a *prima facie* case of evidence as a result of the errors in the findings given by the examiner that underpin the legal conclusion of obviousness. It is respectfully requested that this rejection be withdrawn. Furthermore, it is submitted that the claims are patentable over the art of record for at least these reasons.

Please note that none of the amendments made to the claims are being made in response to this rejection. None of the amendments are intended to narrow the scope of the claims in any way.

Returned Form 1449

Applicants would like to point out that four pages of a substitute Form PTO 1449 for unrelated application serial number 10/190,844 were attached to the back of the July 21, 2008 Office action. Applicants presume that these pages were included inadvertently and, therefore, are not relevant prior art in the referenced application.

For the reasons given, it is submitted that the application is condition to be allowed, and such action is respectfully requested.

Applicants hereby authorize the Commissioner to charge any fees due but not submitted with this paper to Deposit Account No. 07-0153. The Examiner is respectfully requested to call Applicant's Attorney for any reason that would advance the current application to issue. Please reference Attorney Docket No. 132538-1016.

Respectfully submitted,

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